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EXAMINER
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PACHOL, NICHOLAS C

ART UNIT	PAPER NUMBER
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4178

NOTIFICATION DATE	DELIVERY MODE
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01/25/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
debra.hawkins@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/816,823	<b>Applicant(s)</b> DOI ET AL.	
	<b>Examiner</b> Nicholas C. Pachol	<b>Art Unit</b> 4178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/05/04</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 16 claims “a program executed in an image forming apparatus...”

However, the claims do not define a program to be a functional descriptive material encoded on a memory/disk/computer-readable medium, and is thus non-statutory for that reason (i.e., “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized”). Moreover, a “program” is neither a process (“action”), nor machine, nor manufacture, nor composition of matter (i.e., tangible “thing”) and therefore non-statutory.

Such claimed “program” (software) does not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program’s functionality to be realized. As such, “program”/software, not claimed as embodied/encoded in computer-readable medium and is not statutory because the “program”/software is not capable of causing functional change in the computer. Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory and appears to be one type of claim that is considered nonstatutory, under the

present USPTO Interim Guidelines, 1300 Official Gazette Patent and Trademark Office 142 (Nov. 22, 2005).

The Examiner suggests amending the claim to include the disclosed tangible computer readable media, while at the same time excluding the intangible media such as signals, carrier waves, etc...

Any amendment to the claim should be commensurate with its corresponding disclosure.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 8-11, and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanimoto (US 2003/0081261).

Regarding Claim 1, Tanimoto teaches an image forming apparatus (Page 2, paragraph 28) for transmitting and receiving data to/from an external apparatus (Page 2, paragraph 29), the image forming apparatus comprising:

a communication unit that accesses the external apparatus (Page 3, paragraphs 41 and 42), and when the external apparatus stores image data addressed to the image forming apparatus, obtains the image data (Page 4, paragraph 45);

an image forming unit that performs an image forming operation according to the obtained image data (Page 5, paragraph 53);

a power-saving control unit that controls a power-saving mode to be activated or deactivated (Page 5, paragraph 53); and

a communication control unit that controls the communication unit to make an access to the external apparatus while the power-saving mode is deactivated (Figure 5, element S3, and paragraphs 44 and 53).

Regarding Claim 2, Tanimoto further teaches wherein the access is made when the power-saving mode gets deactivated (Page 6, paragraph 68).

Regarding Claim 3, Tanimoto further teaches wherein the access is made when an image forming operation ends (Page 6, paragraph 67).

Regarding Claim 8, Tanimoto teaches an image forming system (Figure 1 and Page 2, paragraph 29) comprising: a server for storing image data (Figure 1, element 40 and Page 2, paragraph 29); and an image forming apparatus for transmitting and receiving data to/from the server via a network (Figure 1, element 20 and Page 2, paragraphs 28 and 29), wherein

the server includes:

a storage unit that stores image data in correspondence with a network address (Page 4, paragraph 45); and

a transmission unit that, in response to a request by an external terminal, transmits image data that corresponds to a network address of the external terminal (Page 4, paragraph 45), and

the image forming apparatus includes:

a request unit that accesses the server and requests, from the server, image data addressed to the image forming apparatus (Page 5, paragraph 53);

a reception unit that receives the image data transmitted from the server (Page 5, paragraph 53);

an image forming unit that performs an image forming operation according to the received image data (Page 5, paragraph 53);

a power-saving control unit that controls a power-saving mode to be activated or deactivated (Page 3, paragraph 37); and

a request control unit that controls the request unit to access the server while the power-saving mode is deactivated (Page 3, paragraphs 37 and 41).

Regarding Claim 9, Tanimoto teaches an image forming method executed in an image forming apparatus (Page 2, paragraphs 29 and 30, where there is a method to perform the stated operations), the image forming apparatus having a power-saving unit that controls a power-saving mode to be activated or deactivated (Page 2, paragraphs

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30 and 31), and being for transmitting and receiving data to/from an external apparatus (Page 2, paragraphs 30 and 31), the image forming method comprising:

an image-data obtaining step of making an access to the external apparatus while the power-saving mode is deactivated (Figure 5, element S3, and paragraphs 44 and 53), and of, when the external apparatus stores image data addressed to the image forming apparatus, obtaining the image data (Page 4, paragraph 45); and

an image forming step of performing an image forming operation according to the obtained image data (Page 5, paragraph 53).

Regarding Claim 10, Tanimoto further teaches wherein the access is made when the power-saving mode gets deactivated (Page 6, paragraph 68).

Regarding Claim 11, Tanimoto further teaches wherein the access is made when an image forming operation ends (Page 6, paragraph 67).

Regarding Claim 15, Tanimoto further teaches wherein the external apparatus functions as an electronic mail server (Page 4, paragraph 45), and the image data obtained at the image-data obtaining step from the external apparatus is image data attached to electronic mail (Page 5, paragraph 51).

Regarding Claim 16, Tanimoto teaches a program executed in an image forming apparatus (Page 3, paragraph 34), the image forming apparatus having a power-saving

unit that controls a power-saving mode to be activated or deactivated (page 5, paragraph 53), and being for transmitting and receiving data to/from an external apparatus (Page 2, paragraphs 30 and 31), the program making the image forming apparatus perform:

an image-data obtaining operation of accessing the external apparatus while the power-saving mode is deactivated (Figure 5, element S3, and paragraphs 44 and 53), and of, when the external apparatus stores image data addressed to the image forming apparatus, obtaining the image data (Page 4, paragraph 45); and

an image forming operation of performing an image forming operation according to the obtained image data (Page 5, paragraph 53).

Regarding Claim 17, Tanimoto teaches a computer-readable recording medium that stores therein a program executed in an image forming apparatus (Page 3, paragraph 34), the image forming apparatus having a power-saving unit that controls a power-saving mode to be activated or deactivated (page 5, paragraph 53), and being for transmitting and receiving data to/from an external apparatus (Page 2, paragraphs 30 and 31), the program making the image forming apparatus perform:

an image-data obtaining operation of accessing the external apparatus while the power-saving mode is deactivated (Figure 5, element S3, and paragraphs 44 and 53), and of, when the external apparatus stores image data addressed to the image forming apparatus, obtaining the image data (Page 4, paragraph 45); and



an image forming operation of performing an image forming operation according to the obtained image data (Page 5, paragraph 53).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-7, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimoto (US 2003/0081261) in view of Gu (US 6,744,780).

Regarding Claim 4, Tanimoto does not teach wherein the communication control unit further controls the communication unit to make another access to the external apparatus when a first time period has passed after a last access to the external apparatus.

However, Gu does teach wherein the communication control unit further controls the communication unit to make another access to the external apparatus when a first time period has passed after a last access to the external apparatus (Column 3, lines 13-20, where the polling is the access to the external apparatus).

Therefore it is obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Tanimoto with the teachings of Gu for the

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purpose of decreasing the traffic activity produced by the network elements (Gu: Column 1, lines 48-51)

Regarding Claim 5, Tanimoto does not teach a prohibition unit that prohibits the communication unit from accessing the external apparatus, until a second time period has passed after a last access to the external apparatus.

However, Gu does teach a prohibition unit that prohibits the communication unit from accessing the external apparatus, until a second time period has passed after a last access to the external apparatus (Column 8, lines 30-52).

Therefore it is obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Tanimoto with the teachings of Gu for the purpose of decreasing the traffic activity produced by the network elements (Gu: Column 1, lines 48-51)

Regarding Claim 6, wherein the power-saving control unit activates the power-saving mode when no image forming operation is performed for a third time period, and the second time period is shorter than the third time period (Page 5, paragraph 67, where since the user can set up the time for warming up to improve the energy saving, the user can set the time intervals so that the second time period, taught in Gu, is shorter than the third time period).

Regarding Claim 7, Tanimoto further teaches wherein the external apparatus functions as an electronic mail server, and the image data that the communication unit obtains from the external apparatus is image data attached to electronic mail (Page 5, paragraph 51).

Regarding Claim 12, Tanimoto does not teach wherein in the image-data obtaining step, another access to the external apparatus is performed when a first time period has passed after a last access to the external apparatus.

However, Gu does teach wherein in the image-data obtaining step, another access to the external apparatus is performed when a first time period has passed after a last access to the external apparatus (Column 3, lines 13-20).

Therefore it is obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Tanimoto with the teachings of Gu for the purpose of decreasing the traffic activity produced by the network elements (Gu: Column 1, lines 48-51)

Regarding Claim 13, Tanimoto does not teach wherein the image-data obtaining step includes an access prohibition substep of prohibiting an access to the external apparatus, until a second time period has passed after a last access to the external apparatus.

Gu does teach wherein the image-data obtaining step includes an access prohibition substep of prohibiting an access to the external apparatus, until a second

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time period has passed after a last access to the external apparatus (Column 8, lines 30-52).

Therefore it is obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Tanimoto with the teachings of Gu for the purpose of decreasing the traffic activity produced by the network elements (Gu: Column 1, lines 48-51)

Regarding Claim 14, Tanimoto further teaches wherein the power-saving control unit activates the power-saving mode when no image forming operation is performed for a third time period, and the second time period is shorter than the third time period (Page 5, paragraph 67, where since the user can set up the time for warming up to improve the energy saving, the user can set the time intervals so that the second time period, taught in Gu, is shorter than the third time period).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas C. Pachol whose telephone number is 571-270-3433. The examiner can normally be reached on M-T, 7:00 a.m.-5:30 p.m. (EST), Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hai Tran can be reached on 571-272-7305. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NP

01/16/08

/Hai Tran/

Supervisory Patent Examiner, Art Unit 4178